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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,799	01/11/2002	Steven Donders	14971	5613

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Garden City, NY 11530

EXAMINER

SCHIFFMAN, JORI

ART UNIT PAPER NUMBER

3679

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/030,799

Applicant(s)

DONDERS, STEVEN

Examiner

Jori R. Schiffman

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-20, 23 and 26-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-19 is/are allowed.
- 6) ☒ Claim(s) 20, 23 and 26-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

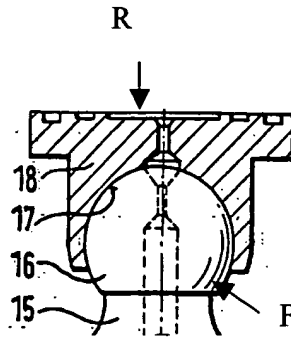
Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 20 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Wagenseil (US 5007332).

Regarding claims 20 and 23, Wagenseil discloses (Fig. 1) a ball-and-socket joint (16, 17) forming a connection between a piston 1 and a slipper 18 of a piston machine, the joint comprising a hemispherical joint recess 17 having a free recess edge, labeled as F on the Figure below, provided at one end of the piston, and a spherical joint ball 16 on the slipper being pivotably mounted in the joint recess 17. Wagenseil further discloses an outer lateral surface converging conically toward the free recess edge F, and the piston being made of hardened steel which is hardened through nitriding (col.4, l. 1-5).

Wagenseil does not specifically disclose that the free recess edge is formed by hot-beading. However, applicant is reminded that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Therefore this limitation has not been given patentable weight.



Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagenseil (US 5007332).

Referring to claims 26 and 27, Wagenseil discloses the claimed joint except for the slipper being formed of steel. Applicant is reminded that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). It would have been obvious at the time the invention was made to a person of ordinary skill in the art to construct the slipper of Wagenseil of steel since it is a well-known material used in ball-and-socket joints including pistons and slippers.

Art Unit: 3679

4. Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagenseil (US 5007332) as applied to claims 23, 26, and 27 above, and further in view of Wiethoff (US 3828654).

Regarding claim 28, Wagenseil discloses the claimed joint including a base surface on the slipper with a recess, labeled as R on the Figure above, but fails to disclose the slipper including a base surface with a plate-shaped insert being mounted in the recess. Wiethoff teaches a plate shaped insert 132 mounted in the recess of the base member of the slipper. It would have been obvious at the time the invention was made to a person of ordinary skill in the art to include a plate shaped insert mounted in the recess of the base member of the slipper so the slipper can slide more easily.

As to claim 29, Wiethoff fails to disclose the material from which the plate shaped insert is made. Applicant is reminded that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). It would have been obvious at the time the invention was made to a person of ordinary skill in the art to construct the insert of either bronze or brass since it is a well-known material in the art.

Allowable Subject Matter

5. Claims 16-19 are allowed.

Response to Arguments

6. Applicant argues that the instant invention functions differently than the prior art. The examiner agrees. However, as discussed above, once the examiner has found a product appearing to be substantially identical in structure to the claimed product, the burden shifts to the applicant to show an unobvious difference. See MPEP 2113. Applicant has not provided *structural* “evidence establishing an unobvious difference between the claimed product and the prior art product.” In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983), and thus has not overcome the rejection. The Examiner suggests claiming the structural differences in the instant invention from the prior art which cause these different functions.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3679

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jori R. Schiffman whose telephone number is 703-305-4805.


The examiner can normally be reached on M-Th, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jori R. Schiffman
Examiner
Art Unit 3679

JS


John Cottingham
Primary Examiner